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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 940

CRANE PACKING COMPANY, A CORPORATION, BETH BERNICE GREEN, INDIVIDUALLY AND AS EXECUTRIX OF EARL J. BULLARD, DECEASED, AND RONALD EUGENE GREEN AND JANIS LEANORE GREEN, MINORS, BY BETH BERNICE GREEN, THEIR NEXT FRIEND,

Petitioners,

vs.

SPITFIRE TOOL & MACHINE CO., INC., A CORPORATION,

Respondent.

PETITIONERS' REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

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Respondent, in its opposing brief suggests (pp. 1, 10), citing no authority, that a petition for rehearing should have been filed in the Court of Appeals before filing the petition for a writ of certiorari.

No statute, no rule, and no decision makes or even suggests such a requirement. It is not the function of a petition for rehearing merely to re-argue a point expressly decided. Cf. Rule 58(2) of this Court.

Respondent contends (p. 6) that certiorari should not be granted because there is no conflict between the ultimate conclusion of the District Court and the Court of Appeals herein, and that this Court "has consistently refused to review concurring holdings of lower tribunals". This contention is unsound. Respondent refers repeatedly to *The Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corp.*, 340 U. S. 147. There this Court, on writ of certiorari, reviewed and reversed concurring conclusions of the District Court and the Court of Appeals.

Reply to Question 1.

Respondent implies, again without authority (p. 2), that this Court should not bother with Question 1 presented by our petition because the *trial* court in addition found that Claims 11 to 14 inclusive were invalid for lack of invention and anticipation and that such finding "was not disturbed" by the Court of Appeals which affirmed the trial court's judgment of invalidity.

The petition here is for a writ of certiorari to review the judgment of the Court of Appeals, not the findings or reasoning of the trial court (Pet. p. 1). Affirmance of a judgment is not (without an express statement to that effect) an adoption of the findings, conclusions or opinion of the court below. *Victor Talking Machine Co.* v. *Hoschke* (C. A. 2, 1911), 188 Fed. 326, 329.

Because the District Court believed the provisions of Section 102(b) of the statute (35 U. S. C.) to be incorporated into Section 251 by reference, it held

(1) That claims 11-14 were invalid because of public use for a period of more than one year before the application for reissue was filed. (Pet. App. B, pp. 31, 32.)

(2) That Roshong Patent No. 2,627,144 (R. 773), although applied for on March 21, 1950, more than two years subsequent to the Bullard application date, was effective "prior art", and that it, with the earlier Morton patent (R. 727), and Desenberg patent (R. 749) rendered such claims 11-14 invalid for lack of invention and anticipation. (Pet. App. B, pp. 33-34.)

However, the Court of Appeals did not accept this second ground for invalidity of claims 11-14. The Roshong patent No. 2,627,144 was issued to petitioner Crane Packing Company and is expressly an improvement upon the Bullard patent in suit, as appears upon its face (R. 775). To hold an invention anticipated and lacking in invention because of a later improvement thereon was too incongruous for the Court of Appeals to accept. It therefore expressly limited its holding of invalidity of claims 11-14, saying:

> "The District Court did not err in holding § 102(b) applicable and that claims 11 to 14, inclusive, were invalid because of public use and sale of Bullard's commercial device more than one year prior to the application for the reissue patent." (Pet. App. B, p. 43.)

In such circumstances the review by certiorari in this Court is of the reasoning of the Court of Appeals, and such review is not to be avoided by pointing to some other ground of dismissal found by the trial court which might not be deserving of review. Thus, in *Steele* v. *L. & N. R. R. Co.*, 323 U. S. 192 (1944), this Court said, at page 197, note 1:

> "The respondents urge that the Circuit Court sustained their demurrers on the ground that the suit could not be maintained against the Brotherhood, an unincorporated association, since by Alabama statute such an association cannot be sued unless the action lies against all its members individually, and on several other state-law grounds. They argue accordingly that

> the judgment of affirmance of the state Supreme Court may be rested on an adequate non-federal ground. As that court specifically rested its decision on the sole ground that the Railway Labor Act places no duty upon the Brotherhood to protect petitioner and other Negro firemen from the alleged discriminatory treatment, the judgment rests wholly on a federal ground, to which we confine our review."

Moreover, the trial court's finding of invalidity of Claims 11 to 14, inclusive, for lack of invention and anticipation was based principally on the Roshong patent. As to the propriety of using this reference the trial court said:

> "Since, as I pointed out in defendant's second contention, the reissue patent, as to Claims 11 to 14, speaks from the filing date, June 25, 1953, the Roshong patent No. 2,627,144 is a valid reference under the defense of anticipation because it was issued February 3, 1953, on an application filed March 21, 1950." (Pet. App. B, p. 33.)

Thus the trial court acknowledged that using Roshong patent No. 2,627,144 as a prior art reference is proper *only* if its decision on the interpretation of the reissue statute is correct.

Therefore, if this Court in considering Question 1 presented by our petition for certiorari, decides that the Court of Appeals (and trial court) erred in interpreting the reissue statute, and that reissue claims 11 to 14, inclusive, relate back, for the purposes of determining validity, to date of filing the application for the original patent, March 12, 1948 (R. 711), it follows that Roshong is not a valid reference and the trial court's finding of invalidity of Claims 11 to 14, inclusive, for lack of invention and anticipation falls with the decision on Question 1. As stated in Rule 23(1)(c) of this Court:

* * * * *

"(c) The statement of a question presented will be deemed to include every subsidiary question fairly comprised therein. * * *"

If, however, as respondent now contends, Bullard claims 11-14 have been held anticipated and rendered invalid by the later improver, Roshong, then there is all the more reason why the petition should be granted. There is great need to settle once and for all the the obvious confusion and incongruous results which have arisen because of the fundamental error in assuming that Section 102(b) of the Patent statute must be considered as incorporated into Section 251 of the same statute, thereby nullifying other provisions of the same statute.

Respondent argues (p. 9) that petitioners have omitted and ignored a portion of Section 252 (35 USC), and that such portion renders untenable petitioners' interpretation of Sections 251 and 252. It is the respondent who has induced the Courts below to give an effect to Section 252 which is not warranted by the language of that section.

Section 252 has to do with the effect of a reissue patent already granted, not with an application for reissue of a patent. The language of this section specifically uses the words "patent", not "application for patent". The first paragraph, which is the only one involved here (Pet. App. A, p. 22), deals with actions on an original patent which is surrendered, and with causes of action existing at the time of the surrender of the patent. It permits a continuation of a pending action for infringement and also the filing of an action for past infringement after the original patent upon which such actions are founded has been surrendered and has no legal existence.

Similarly, Section 251 has been read by the Court of Appeals to embrace conditions of patentability whereas the language of that section specifically states that the provisions of this title (Title 35) "relating to *applications*"

for patent shall be applicable to applications for reissue. The only provisions of Title 35 "relating to applications" for patent are found in Chapter 11 entitled "Applications for Patent" and Chapter 12 entitled "Examination of Application", neither of which includes Sections 102 and 103. The latter are contained in Chapter 10 entitled "Patentability of Inventions" and set forth the conditions for patentability, not what the contents of an application shall be, nor the manner in which examination thereof shall be conducted.

The failure of the Court of Appeals to adhere to the language of Section 251 has led to the compounding of the error it committed in reading Section 252 and has caused it to arrive at a result contrary to that adhered to for many years by the Courts, the Patent Office and the Patent Bar (See Pet. pp. 10-12).

Petitioners' interpretation gives full meaning to the wording of the first paragraph of Section 251, which the Court of Appeals has failed to do, and from which the nature of a reissue patent is made clear. This paragraph states that

> "* * * the Commissioner shall, * * * reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, * * * No new matter shall be introduced into the application for reissue."

Since the reissue patent is based on an amended application for the same invention and no new matter can be introduced into the application for reissue, any reissue claim not identical with an original claim must be directed to the invention disclosed in the original patent. But this invention satisfied the provisions of Sections 102 and 103 as to conditions for patentability at the time of application for the original patent, and hence each claim not identical with an original claim, necessarily being for the same

invention, has already satisfied Sections 102 and 103. It is only as to "inventions," not amended applications, that these sections apply.

Published Comment Re Question 1.

That the incongruity of the decision of the Court of Appeals in the instant case is already becoming a matter of general public concern is evident from the comment in the May 10, 1960, issue of U. S. Law Week, 28 L. W. 1169:

> "A troubling feature of the case is the fact that, by the same logic, the original patent itself might constitute a statutory bar. This reasoning, in effect, would outlaw a broadened reissue more than one year after the original grant despite the fact that Section 251 specifically permits broadened reissues within two years."

Reply to Question 2.

Whether there are features or elements in prior art devices which could be combined to make up a later invention is of course a matter of fact. But whether one may make up a synthetic combination of prior art without any suggestion in the prior art to do so and thereby invalidate the later patent is not an issue of fact but strictly one of law. The legal principle to this effect pronounced in *Bates* v. *Coe*, 98 U. S. 31, 48, has long been established. The lack of any such suggestion is apparent from the art cited.

Respondent says (p. 3) that no testimony was "adduced" by petitioners in the court below relative to "the Morton patent" or "to any of the prior art patents". We do not understand respondent's interpretation of "adduced". Respondent's witness, Jeffers, was cross-examined by petitioners and conceded (R. 381) that he took certain elements from the Morton reference, and other elements from other patents which he "combined" "for the purpose of meeting

the claims". This is precisely what this Court said in *Bates* v. *Coe*, 98 U. S. 31, 48, that an infringer cannot do to avoid liability.

The issue on the second ground of the petition is not the factual issue of what the prior art discloses but is the legal issue as to the use which can be made thereof to anticipate a later patent.

This likewise is an important question of patent law which the Court of Appeals has failed properly to apply, contrary to the decisions of this Court.

Conclusion.

For the reasons stated herein and in the petition, we respectfully submit that this Court should issue its writ of certiorari to review the judgment of the Court of Appeals for the Seventh Circuit entered in this case April 1, 1960.

Respectfully submitted,

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